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APPLICATION NO. FILING DATE FIRST NAMED INVENTOR ATTORNEY ONFIRMATION NO. 8169 10/671,515 09/29/2003 Gregory L. Onken EXAMINER 22907 7590 03/08/2004 **BANNER & WITCOFF** JOYCE, HAROLD 1001 G STREET N W ART UNIT PAPER NUMBER **SUITE 1100** WASHINGTON, DC 20001 3749

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| *** | Application No. | Applicant(s) |
|---|--|---|
| Office Action Summary | 10/671,515 | ONKEN, GREGORY L. |
| | Examiner | Art Unit |
| | Harold Joyce | 3749 |
| The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply | | |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). | | |
| Status | | |
| 1) Responsive to communication(s) filed on | _• | |
| 2a) This action is FINAL . 2b) This action is non-final. | | |
| 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is | | |
| closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. | | |
| Disposition of Claims | | |
| 4) Claim(s) 1-38 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) Claim(s) is/are allowed. 6) Claim(s) 1-38 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or election requirement. | | |
| Application Papers | | |
| 9)☐ The specification is objected to by the Examine 10)☑ The drawing(s) filed on 29 September 2003 is/a Applicant may not request that any objection to the or Replacement drawing sheet(s) including the correction 11)☐ The oath or declaration is objected to by the Examine 11. | re: a) \boxtimes accepted or b) \square objecd drawing(s) be held in abeyance. See on is required if the drawing(s) is obj | e 37 CFR 1.85(a). ected to. See 37 CFR 1.121(d). |
| Priority under 35 U.S.C. § 119 | | |
| 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. | | |
| Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date | 4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other: | |

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43 of U.S. Patent No. 5,807,046. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differs from the patented claims in the elimination of elements, it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit elements, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harold Joyce whose telephone number is (703) 308-0274. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on (703) 308-1935. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harold Joyce Primary Examiner Art Unit 3749